Accordingly, applicants have revised the wording of Claim 1 to further emphasize that the initiator system which is added in accordance with applicants' process is "a solution consisting of" the free-radical initiator and a certain liquid polyethylene glycol. Additionally, applicants have clarified that the certain polyethylene glycol is liquid at room temperature.[2] New Claims 18 to 21 have been added to further being out some of the features of the solid polyether grafting base (b).[3] No new matter has been added.

The Examiner rejected Claims 1 to 3 and 10 under 35 U.S.C. §102(b) as being anticipated by the teaching of *GB 922,457*. The Examiner pointed out, inter alia, that the reference addresses a process in which graft copolymers of polyalkylene glycols are prepared by polymerizing suitable monomers such as vinyl esters in the presence of the polyalkylene glycols by adding a free-radical catalyst,

- that the polyalkylene glycols are employed by "dissolving the polyalkylene glycol in at least one monomer in the presence or absence of additional solvent,"[4] and
- that the polyalkylene glycols suitable for the graft copolymerization "have a molecular weight of 106 to several millions, preferably in the range from 1,000 to 30,000."[5]

However, as further emphasized in the wording of Claim 1 as herewith presented, it is mandatory for applicants' process that "a solution consisting of a free-radical initiator and a *liquid* polyethylene glycol having a molecular weight between 88 and 1000 which polyethylene glycol is liquid at room temperature"[6] be added as the free-radical initiator system, and that the polyether component (b) which is employed in the polymerization procedure be *solid* at room temperature.

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed.[7] The fact that claimed subject matter may be encompassed by a generic disclosure does not by itself estab-

2) Cf. eg. page 3, indicated lines 9 to 12, of the application.

3) Cf. page 5, indicated lines 15 to 19, of the application.

4) Cf. page 1, indicated lines 63 to 66, of *GB 922,457*.

5) Cf. page 2, indicated lines 70 to 73, of *GB 922,457*.

6) emphasis added.

7) Cf. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985); *In re Marshall* 577 F.2d 301, 198 USPQ 344 (CCPA 1978); *In re Kalm* 378 F.2d 959, 154 USPQ 10 (CCPA 1967).

lish obviousness of the claimed subject matter,[8] and anticipation is the ultimate or epitome of obviousness.[9] Anticipation under Section 102 requires therefore more than a generic disclosure which encompasses claimed subject matter. The test for anticipation is one of identity which means that the identical invention must be shown in the reference in as complete detail as is contained in the claim.[10] In fact, the Federal Circuit has stated that it is error to treat claims as a catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims that give those claims their meaning.[11]

Applicants' procedure is clearly distinguished from the process which is described in the teaching of *GB 922,457* due to the particularities of the initiator system which is employed in accordance with applicants' invention because the free-radical catalyst is employed in accordance with British reference in form of a solution comprising the monomer, the polyalkylene glycol and the free-radical catalyst.[12] Applicants' process further differs from the process which is described in the teaching of *GB 922,457* in that a certain *solid* polyether is employed as component (b) and a certain *liquid* polyethylene glycol is employed as a co-constituent of the initiator system. The teaching of the British reference clearly fails to describe any polymerization in which these requirements of applicants' invention are met. According to the reference, the monomers and optionally additional -albeit unspecified- solvents are employed to dissolve the polyalkylene glycol and the free-radical catalyst.[13] It is also noted that the polyalkylene glycols which are employed in the illustrative examples are solids with molecular weights in the range of from 1,540 to 1,000,000. As such, the teaching of *GB 922,457* cannot reasonably be considered to provide an identical description of applicants' in-

8) Cf. *In re Baird*, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); see also *Corning Glass Works v. Sumitomo Electric U.S.A.*, 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989), which holds that a genus does not inherently disclose all species; and *In re Jones*, 958 F.3d 347, 21 USPQ2d 1614 (Fed. Cir. 1992), which holds that a genus does not render all species that happen to fall within the genus obvious.

9) Cf. *In re Grose*, 592 F.2d 1161, 201 USPQ 57 (CCPA 1979).

10) Cf. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989).

11) Cf. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

12) Cf. eg. Example 2, page 4, indicated line 85 et seq., and Example 4, page 5, indicated line 26 et seq., of *GB 922,457*.

13) Cf. page 1, indicated lines 63 to 66, page 2, indicated lines 21 to 24, and the representative examples of *GB 922,457*.

vention, including the part-to-part relationship of the elements recited in applicants' claims as is necessary for a finding of anticipation under Section 102. It is therefore respectfully urged that the rejection of Claims 1 to 3 and 10 under Section 102(b) based on the teaching of *GB 922,457* be withdrawn. Favorable action is solicited.

For completeness sake it is also respectfully noted that the process defined in applicants' claims is deemed to meet the provisions for patentability set forth in Section 103(a) when applicants' invention as a whole is considered in relation to the teaching of *GB 922,457*.

To establish a prima facie case of obviousness, three basic criteria must be met.[14] First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success, and, finally, the prior art reference must teach or suggest all the claim limitations. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and cannot be based on the applicant's disclosure. Accordingly, the mere fact that the prior art can be modified in some manner so as to arrive at a claimed invention does not support a conclusion of obviousness where the prior art fails to suggest the desirability of the specific modification which is required.[15] Where the elements of applicants' invention are concerned the teaching of *GB 922,457* fails to establish a prima facie case of obviousness because at least the suggestion or motivation to do what applicants have done is lacking, and the reference fails to teach or suggest all of the elements of applicants' process.

In light of the foregoing and the attached it is therefore respectfully urged that Claims 1 to 3, 10 and 18 to 21 define patentable subject matter and that the application is in condition for allowance. Favorable action by the Examiner is solicited.

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14) Cf. eg. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999); MPEP §2143.

15) Cf. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); see also, eg., *Interconnect. Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985).

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REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. The respective $1020.00 fee is paid by credit card (Form PTO-2038 enclosed).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,
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Encl.: CLAIM AMENDMENTS (Appendix I)

JDV/BAS